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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MITCHELL S. OWENS and MICHAEL T. WYMAN

Appeal 2008-4654
Application 10/661,157
Technology Center 3700

Decided: January 12, 2009

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
JOHN C. KERINS, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Mitchell S. Owens and Michael T. Wyman (Appellants) seek our review under 35 U.S.C. § 134 of the non-final rejection¹ of claims 1, 2, 4, 6,

¹The claims on appeal have been twice rejected. As such, we have jurisdiction to address the case on the merits. *Ex parte Lemoine*, 46 USPQ2d 1432, 1434 (Bd. Pat. App. & Int. 1995).

and 8-13. We have jurisdiction under 35 U.S.C. § 6(b) (2002). The Examiner indicated that claims 15-20 are allowed, and that claims 5, 7, and 14 contain allowable subject matter, but are objected to as being dependent on a rejected base claim. Claim 3 has been withdrawn from consideration.

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellants' claimed invention is to a security enclosure for a control apparatus having a base and a cage configured to connect to the base and encompass the control apparatus. The security enclosure further has a mounting member comprising a mounting shank and a mounting strap joined to the mounting shank, the mounting shank being embedded within the base, and the mounting strap being partially embedded within the base. A lock device configured to secure the cage to the mounting strap is also provided. (Appeal Br., Claims Appendix, claim 1).

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A security enclosure for a control apparatus,
said enclosure comprising:

a base;

a cage configured to connect to said base and
encompass said apparatus;

a mounting member comprising:

a mounting shank embedded within said base; and

a mounting strap partially embedded within said base and joined to said mounting shank, and configured to extend inside said cage substantially perpendicular to said base when said cage is connected to said base; and

a lock device configured to secure said cage to said mounting strap when said cage is connected to said base.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Davenport	US 4,890,638	Jan. 2, 1990
Clements	US 6,203,591 B1	Mar. 20, 2001

Guardshack Product Line Brochure (Backflow Prevention Device InnClosures, Phoenix, Az., 2000) (hereafter “Guardshack”).

The Examiner maintains the following rejections:

Claims 1, 2, 4, and 6 are rejected under 35 U.S.C. § 102(b) as being anticipated by Davenport.

Claims 8-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davenport in view of Guardshack.

Claims 12 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Davenport in view of Guardshack and Clements.

Appellants omitted from the “Grounds of Rejection to be Reviewed on Appeal” the Examiner’s rejection of claims 8-11 and of claims 12 and 13 under 35 U.S.C. § 103(a). (Appeal Br. 8). Appellants, however, appear to be seeking a reversal of these rejections. *See e.g.*, Appeal Br. 4 (stating that

“[C]laims 1-2, and 4-14 are on appeal.”); Appeal Br. 22 (stating that “...Appellants believe claims 2 and 4 through 14 to be allowable by reason of dependency.”); Appeal Br. 22, (“Conclusion” section summarizing that the appeal is directed to claims 1-2 and 4-20).

It thus does not appear that Appellants intended to withdraw claims 8-13 from the appeal. As such, *Ex parte Ghuman*, No. 2008-2642, 2008 WL 4768098, (BPAI Oct. 31, 2008), does not apply, and we will not remand the case to the Examiner for cancellation of these claims. Rather, we understand Appellants to be seeking reversal of the rejection of claims 8-13 for the same reasons as argued for claim 1, from which they depend. Because no separate arguments were presented for patentability of claims 8-13, we will treat these dependent claims in accordance with our treatment of independent claim 1.

ISSUES

The Examiner contends that the Davenport patent discloses a mounting shank (central anchor hook 112) embedded within a base, a mounting strap (portion of frame 107 and lateral anchor hook 112) partially embedded within the base, and a lock device (fastener bolt 115) to secure a cage to the mounting strap.

Appellants urge that Davenport does not disclose a lock device as defined by Appellants, and that the Examiner has improperly and erroneously read the disclosure of Davenport on claim 1, specifically that it is improper to regard one anchor hook as corresponding to the mounting shank and another anchor hook as a component of a mounting strap.

The issues joined in this appeal are: whether the claimed lock device

excludes from its scope a fastener bolt, and whether the Examiner has improperly interpreted the Davenport disclosure in finding that Davenport teaches the provision of a mounting shank and a mounting strap, as set forth in claim 1?

FINDINGS OF FACT

The following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

FF 1. The Davenport patent discloses the use of fastener bolts 115 that are used to secure a cage 90 to a mounting strip (perpendicularly-extending portions 106, 107) when the cage is positioned on and connected to base 22. (Davenport, Fig. 10; Col. 6, ll. 44-58).

PRINCIPLES OF LAW

Anticipation (unpatentability under 35 U.S.C. § 102) is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444 (Fed. Cir. 1984).

During prosecution of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Care must be taken to not read a particular embodiment appearing in the written description into the

claim if the claim language is broader than the embodiment. *See Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

ANALYSIS

Appellants assign error only to the ground of rejection under 35 U.S.C. § 102(b), and present arguments only with respect to claim 1. Appellants assert that claims 2 and 4-14 are allowable by reason of their being dependent from claim 1.

Appellants contend that the Davenport patent, when properly construed, does not disclose a mounting shank, a mounting strap, or a lock device. Taking this last claim element first, Appellants argue that the fastener bolts 115 in Davenport, identified by the Examiner as corresponding to the claimed lock device, can not be construed as such. (Reply Br. 14). Specifically, Appellants contend that fastener bolts do not fall within the term “lock device”, as defined in the Specification, in that the term “lock device” clearly intends to exclude common fasteners, and further that a “lock device” is not comparable to a “locking device”. (Reply Br. 12-13; Appeal Br. 18-20).

Appellants attempt to invoke their right to be their own lexicographer, asserting that “lock device” is a coined term, and is defined in the Specification as “consisting of a lock rod 76 and a lock tab 78.” (Specification [0063]; Appeal Br. 18-19; Reply Br. 12-13). The cited passage in the Specification is not, however, definitional in nature, but is simply a description of a preferred embodiment of Appellants’ claimed “lock device”. Appellants are thus, in reality, seeking to have limitations from the Specification read into claim 1, in order to exclude fasteners such

as bolts from the scope of that claim element. We are not persuaded that such a limited interpretation is appropriate or warranted, given our charge to construe the claim in its broadest reasonable construction, and given the lack of a definition of the term in the Specification and/or any structural limitations imposed on the “lock device” in the language of claim 1.

Appellants, further invoking “the rules of English grammar”, also contend that the claimed “lock device” is to be interpreted in a restrictive manner as being “a device for use with a lock”. (Reply Br. 13). This, according to Appellants, is to be contrasted with a “locking device”, or “a device that locks”. (*Id.*). Appellants assert that they intentionally chose the term “lock device” instead of the term “locking device”, seemingly to buttress their position that the term used in the claim should be read restrictively. Appellants apparently would place fastener bolts into the category of “locking device[s]”, and not “lock device[s]”, although they do not explicitly state this.

The distinction and proposed restrictive interpretation advanced by Appellants find no supporting evidence in the Specification or drawings as filed. The position advanced appears to be little more than a *post hoc* grammatical exercise concocted by Appellants to attempt to distinguish the claim term from the prior art, without actually more specifically defining the term in the claim itself. The claim element must be given its broadest reasonable interpretation, and there is no evidence that persons of ordinary skill in the art would regard the term “lock device” as limited only to devices that are for use with a lock, notwithstanding the possibility that a broader interpretation might not be perfectly in compliance with “the rules of English grammar”.

The claimed “lock device” is not the subject of any special or limiting definition, and is completely devoid of structural features, with the claim merely reciting functional requirements for the device. Those requirements are met by the fastener bolts of Davenport (FF 1), a point which is not disputed by Appellants. Accordingly, the Examiner’s position that the fastener bolts of Davenport read on the claimed “lock device” is not in error.

Appellants further contend that the Davenport patent, if properly interpreted, does not disclose the claimed mounting shank and mounting strap. Appellants’ principal contention is that it is improper and illogical to consider, as has the Examiner, one of the anchor hooks 112 of Davenport as meeting the claim limitation directed to the mounting shank, and to further consider another of the anchor hooks as constituting a component of the claimed mounting strap. (Appeal Br. 11-14; Reply Br. 6-7). Appellants contend that either the collection of anchor hooks of Davenport correspond to the claimed mounting shank, and thus the Davenport mounting strap has no portion partially embedded in the base, or, alternatively, if the anchor hooks are collectively considered to be components of the mounting strap, then the Davenport structure has no structure corresponding to the mounting shank (i.e., a component embedded in the base). (Appeal Br. 12-13).

Appellants denigrate the Examiner’s position as being illogical (*see, e.g.,* Appeal Br. 11), and impermissibly based on the use of hindsight. (Reply Br. 7-9). Appellants’ attack based on the alleged use of hindsight is not well taken, in that the rejection here is one based on anticipation under 35 U.S.C. § 102, whereas an inquiry into the possibility that a rejection improperly uses hindsight reconstruction is pertinent only where the rejection is one grounded in obviousness, under 35 U.S.C. § 103. The

Examiner here has, in any event, not reconstructed the claimed invention from a variety of teachings, rather the Examiner has identified structure in the Davenport patent that structurally and functionally corresponds to the various elements as claimed.

Neither is the Examiner's reading of the structure of Davenport on the claimed mounting shank and mounting strap illogical. As was the case with the claimed "lock device" addressed above, the claimed "mounting shank" and "mounting strap" are not further structurally defined, other than by their orientation or position relative to a base and cage, and that the mounting strap is joined to the mounting shank. (Appeal Br., Claims Appendix, Claim 1).

The Examiner asserts that the central anchor hook 112 of the Davenport mounting member comprises a mounting shank embedded within base 22. (Answer 3). The claimed mounting shank has no recited configurational or structural features that would exclude the disclosed anchor hook. The Examiner further asserts that one of the flanking anchor hooks (the one located below reference numeral 108 in Fig. 9 of Davenport), together with angle members 106, 108, 110 of the angle frame 105 constitute a mounting strap that is joined to the mounting shank 112 and that is partially embedded within the base. (Answer 3, 4). The claimed mounting strap has no recited configurational or structural features that would exclude these components of Davenport from meeting the limitations of the claimed mounting strap.

Appellants argue that this interpretation of Davenport is illogical because persons of ordinary skill in the art would not view the several anchor hooks of Davenport as serving different purposes or different

functions. (Reply Br. 7). Appellants urge that the claimed mounting shank and mounting strap, in contrast, serve two different functions, as evidenced by the fact that they are separately claimed elements. (*Id.*).

These arguments miss the mark. The Examiner must find structural correspondence between the claim elements and the prior art device relied upon in order to establish anticipation. That, the Examiner has done. To the extent that functional aspects of the claimed elements might be relevant, Appellants have pointed to no functional claim language that differentiates the mounting shank or the mounting strap from the portions of the Davenport structure cited by the Examiner. Appellants here, as with the majority of their arguments, fail to maintain focus on the claim as written, and its broadest reasonable interpretation.

A further illustrative example is that Appellants argue that the Davenport anchor hooks are common fasteners, whereas the claimed mounting shank and mounting strap are “anything but common fasteners.” (Appeal Br. 16). However, neither the claim language itself nor the Specification or drawings provide evidence that would require the claim to be read in this or any other particular restrictive manner relative to the construction or configuration of the mounting shank or mounting strap.

Appellants do mount one attack based on language that is actually present in claim 1. Appellants contend that the anchor hook that is cited as corresponding to the mounting shank is only partially embedded in the base, because the anchor hook has a portion that is not embedded in the base. (Appeal Br. 15). This appears to refer to the fact that the uppermost surface of the anchor hook of Davenport is exposed at the top surface 23 of base 22,

notwithstanding that it is fully surrounded by the base material, and no part of the anchor hook projects out of the base. (*See, e.g.*, Fig. 12).

Aside from a further attempt at a *post hoc* grammatical contrasting of terms, this time with “embedded” and “partially embedded”, Appellants point to no evidence that the term “embedded” must be construed in such a restrictive manner. Indeed, the common and ordinary meaning of “embed” is inclusive of the Davenport anchor hook, in that the anchor hook is fixed firmly in a surrounding mass, much like a post in concrete.²

Appellants have not persuasively argued that claim 1 contains claim language that structurally or functionally defines the claimed mounting strap over the angle members and flanking anchor hook of Davenport relied upon by the Examiner. The same is true of the claimed mounting shank and the central anchor hook of Davenport.

We are not persuaded that any factual or legal error was committed by the Examiner in the rejection of claim 1 as anticipated by Davenport. Claims 2, 4, and 6 are also rejected under 35 U.S.C. § 102(b) in view of Davenport, but Appellants do not present any arguments as to the separate patentability of any of these claims. Accordingly, we are not persuaded that error was committed in rejecting these claims.

Claims 8-11 are rejected under 35 U.S.C. § 103(a) over Davenport in view of Guardshack, and claims 12 and 13 are rejected under 35 U.S.C. § 103(a) over Davenport in view of Guardshack and Clements. Appellants have not presented any arguments for patentability beyond those presented

² embed: To fix firmly in a surrounding mass: *embed a post in concrete; fossils embedded in shale. The American Heritage® Dictionary of the English Language* (Fourth Edition; Copyright © 2006 by Houghton Mifflin Company).

for claim 1. Appellants have thus not met their burden of showing error in the Examiner's rejections of these claims, and we will sustain those rejections.

CONCLUSION

Appellants have not established that reversible error exists in the rejection of claims 1, 2, 4, and 6 under 35 U.S.C. § 102(b) in view of Davenport. Appellants have further not established that reversible error exists in the rejection of claims 8-13 under 35 U.S.C. § 103(a) in view of Davenport and Guardshack or Davenport, Guardshack, and Clements.

ORDER

The decision of the Examiner to reject claims 1, 2, 4, 6, and 8-13 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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